

### **REMARKS**

Claims 1, 3, 12, 14, and 37 have been amended. Therefore, claims 1, 3-12, 14-18, and 37-39 are pending in the case. Entrance of the amendments to the claims and further examination and reconsideration of pending claims 1, 3-12, 14-18, and 37-39 are respectfully requested.

### **Section 101 Rejections**

Claims 1-18 and 37-39 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 2 and 13 have been canceled thereby rendering their rejections moot. As will be set forth in more detail below, the § 101 rejections of claims 1, 3-12, 14-18, and 37-39 are respectfully traversed.

Claims 1, 3-12, 14-18, and 37-39 are directed to statutory subject matter when the “machine-or-transformation test” is applied to the present claims. [T]he machine-or-transformation test is the only applicable test and must be applied, in light of the guidance provided by the Supreme Court and this court, when evaluating the patent-eligibility of process claims. *In re Bilski*, F.3d, 88 USPQ2d 1385, 29 (2008). In particular, the present claims recite methods that include at least one step that is performed by a particular machine. For example, amended independent claim 1 recites, in part: “monitoring the performance of the selected investment manager includes electronically generating performance reports using software on a computer.” Independent claims 12 and 37 have been amended to recite similar limitations. Support for the amendments to claims 1, 12, and 37 can be found in the claims as originally filed, for example, in claims 2 and 13 and in the Specification as originally filed, for example, on page 25, lines 9-14 and page 46, lines 1-5. While the software program may not be specifically taught to be on a computer, it is inherent that the software program is run on a computer. Therefore, the amendments to claims 1, 12, and 37 do not present new matter.

Amended independent claims 1, 12, and 37, therefore, recite at least one step that is performed by a particular machine (e.g., a computer). In this manner, the claimed methods are “processes” under § 101, because the claimed methods are tied to another statutory class (e.g., a particular apparatus). Therefore, for at least the reasons set forth above, claims 1, 12, and 37 meet the requirements of the machine-or-transformation test. As such, claims 1, 12, and 37 are patent-eligible process claims.

For at least the reasons set forth above, claims 1, 12, and 37, and claims dependent therefrom, are directed to statutory subject matter. Accordingly, removal of the § 101 rejections of claims 1, 3-12, 14-18, and 37-39 is respectfully requested.

#### **Section 112, second paragraph, Rejections**

Claims 1, 3-12, 14-18 and 37-29 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the claims contains subject matter which was not described in the specification. Applicant has removed the term “performance management system” from the claims. As such, Applicants respectfully submit that the amendments to claims 1, 12, and 37 render the § 112, first paragraph, rejections of claims 1, 12, and 37 moot. Accordingly, removal of the § 112, second paragraph, rejections of claims 1, 12, and 37 is respectfully requested.

#### **Section 103 Rejections**

Claims 1, 3-9, 11-12, 14-17, and 37-39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0188536 to Milosavljevic et al. (hereinafter “Milosavljevic”) in view of U.S. Patent No. 6,064,986 to Edelman. As will be set forth in more detail below, the § 103 rejections of claims 1, 3-9, 11-12, 14-17, and 37-39 are respectfully traversed.

**The cited art does not teach selecting an investment manager.** Independent claim 1 recites, in part: “selecting an investment manager for investing the institutional capital.” Independent claims 12 and 37 recite similar limitations.

Milosavljevic discloses a system and method for an income planner. Milosavljevic does not disclose selecting an investment manager or monitoring the performance of selected investment manager. Examiner states that Edelman teaches selecting an investment manager (See Field of the Invention) and monitoring performance of the selected manager (see Field of the Invention). Edelman does not teach a process used to select an investment manager. Edelman discloses a computer program product, system or process [to] administer or assist in the administration of resources for a customer for the benefit of a beneficiary. (See Abstract). Furthermore, the computer program of Edelman may be administered and/or combined with the feature of an integrated attorney, trustee, and financial advisor network (See column 16, lines 25-29). Again, there is no selection of the investment manager. Edelman discloses reports that can be used by an investment manager, but does not select the investment manager. Since the combination of Milosavljevic and Edelman does not teach all of the claim limitations, claims 1, 12, and 37, as well as claims dependent therefrom are patentable.

For at least the reasons set forth above, independent claims 1, 12, and 37, as well as claims dependent therefrom, are not made obvious by the cited art. Accordingly, removal of the § 103 rejections of claims 1, 3-9, 11-12, 14-17, and 37-39 is respectfully requested.

### **CONCLUSION**

This response constitutes a complete response to all issues raised in the Office Action mailed July 7, 2009. In view of the amendments and remarks presented herein, Applicants assert that pending claims 1, 3-12, 14-18, and 37-39 are in condition for allowance. If the Examiner has any questions, comments, or suggestions, the undersigned earnestly requests a telephone conference.

The Commissioner is authorized to charge any fees, which may be required, or credit any overpayment, to deposit account number 13-0480.

Respectfully submitted,

/Frank M. Gasparo/  
Frank M. Gasparo  
Registration No. 44,700  
Attorney for Applicant(s)

Baker & McKenzie LLP  
1114 Avenue of the Americas  
New York, New York 10036  
Telephone: (212) 626-4100  
Facsimile: (212) 310-1600  
Date January 5, 2009

DALDMS/672987.1